

REMARKS

This Amendment is responsive to the Office Action dated July 26, 2004. In that Action, the Examiner rejected claims 1 and 3-9 under 35 U.S.C. §102 as being anticipated by Case and claims 2 and 9 under 35 U.S.C. §103 as being obvious in view of Case in light of Gartner. The claims were also rejected under 35 U.S.C. §101 and for double patenting. Applicant respectfully traverses the Examiner's rejections of the claims and offers the foregoing amendments and following remarks in support thereof.

Applicant has amended the claims to overcome all 101 rejections. Furthermore, in conjunction with this amendment, a terminal disclaimer is also being filed to overcome the double patenting rejection made by the Examiner.

Claims 1, 9 and 10 have been amended. No new matter has been inserted. Claims 1-10 remain pending in the application. Applicant respectfully requests reconsideration of the Examiner's rejections.

Claims 1 and 3-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by Case. As was properly argued in the parent case to this Examiner, which issued as U.S. Patent No. 5,963,910, and as applied to the present case, the disclosure of Case and Applicant's claimed invention are entirely different. Case merely analyzes decisions that have been made, as opposed to laying out specific information which will enable a user to formulate the optimal strategy or solution to pursue, as taught by Applicant's claimed invention.

Case focuses on a decision table, and looks at why a decision was made. Applicant's claimed invention does not analyze why a decision was made. Rather, Applicant's claimed invention formulates strategies, from scratch, for a user to determine what is the best course of action such user should take regarding a specific mission. Case measures something that

has already happened and thus is an "after the event" product. Applicant's claimed invention measures something that will happen in the future, before the event has happened.

Additionally, Case compares made solutions against other made solutions. On the other hand, Applicant compares proposed user defined solutions against desired outcomes. Thus, Case provides a method to decide how "on the market" alternatives performed against each other. Applicant's claimed invention tests solutions, which may or may not have been considered or exist, to see how they will perform, in the future, in satisfying a prioritize list of desired outcomes and predictive metrics.

Case shows a user the areas for improvement. Applicant's claimed invention provides solutions that will best deliver the most value for those areas of improvements. Accordingly, Case is merely a way to view data, whereas Applicant's claimed invention is a way to formulate optimal strategies.

It is axiomatic that in a proper '102 rejection, every element of the invention as claimed must be contained in the cited reference. Case does not determine an optimal option which best predicts satisfaction of a plurality of desired outcomes.

The claims also further provide general characteristics about the desired outcomes and predictive metrics, and their relationships to each other, which are also not shown in Case. Contrary to the Examiner's comments, Case fails to provide for desired outcomes as claimed and disclosed by Applicant. The various "criteria" of Case are merely vague terminology which are not "desired outcomes" as disclosed by Applicant. Case's "criteria" is also not the equivalent of Applicant's desired outcomes.

Case also fails to provide for any predictive metrics, as disclosed and claimed by Applicant. The disclosure in Case cited by the Examiner (Col 6. line 66 - Col. 7, line 6) fails to teach predictive metrics. This portion of Case merely addresses the importance of the criteria, which fails to correspond to any element of Applicant's claims. As claimed by Applicant,

predictive metrics predict with certainty the satisfaction of at least one desired outcome. Case is clearly silent as to the use of predictive metrics.

Case merely compares differences between average vendor rating scores. Case does not compare a plurality of user defined strategic options to allow the user to determine and select, prior to implementation of any strategic option, which of the user defined strategic options best predicts satisfaction of the desired outcomes.

The data of Case allows for list of criteria that impacted a decision or set of decisions after the decisions have been made. This list of criteria is furthered filtered to provide specific essential criteria which should be focused on by the user in the future. No solution, yet alone an optimal solution, for incorporating the essential criteria into a product or service is provided by Case. Additionally, no predictive metrics are provided for satisfying each of the essential criteria. As such, no evaluation (matrix analysis) of the predictive metrics with the desired outcomes is performed by Case.

In addition to the above, as to Claims 8, 9 and 10, Case fails to disclose ranking of any predictive metrics. Case only ranks its disclosed "criteria". Also, Case discloses assigning a weighted value to the categories of criteria, not to the customer sets surveyed as claimed by Applicant. Furthermore, in addition to assigning importance value to the desired outcomes, Applicant also assigns satisfaction values for each desired outcome. This feature is not shown in Case.

Furthermore, Case and the present invention have completely diverse applications. Case analyzes a decision among at least two alternatives based upon a plurality of criteria. The present invention finds segments of opportunity in a market by finding groups of customers who find different criteria important for satisfaction. The present invention incorporates the customer's desired outcome as one basis for segmenting the market, which is not found in Case at all. .

Thus, in view of the above, Case fails as a proper '102 reference. Accordingly, Applicant respectfully traverses the rejection of claims 1, and 3-9 under 35 U.S.C. §102(b) as being anticipated by Case.

Claims 2 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Case in view of Gartner. Some of the deficiencies of Case have been discussed above. Gartner fails to correct these deficiencies. Gartner fails to teach any subject matter not disclosed in Case, and is merely a promotional document concerning certain same subject matter disclosed in Case. In fact, the assignee of the Case Patent is Gartner.

Page 14 of Gartner does not deal with "predictive metrics" as stated by the Examiner. As stated above and claimed, "predictive metrics" are parameters which predict with certainty satisfaction of at least one desired outcome. These parameters are not present in Gartner nor Case. Page 14 of Gartner is merely concerned with "decision criteria" which impacted a buyer decision for a purchase already made by the buyer. Accordingly, the proposed combination still fails to teach or suggest Applicant's claimed invention.

Accordingly, Applicant respectfully traverses the rejection of claims 2 and 10 under 35 U.S.C. §103(a) as being unpatentable over Case in view of Gartner.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue. There is nothing in the cited art to suggest what Applicant did.

This Amendment claims subject matter not taught or suggested in the prior art, as more fully set out in the arguments above. In view of the above, it is respectfully submitted that the claims are in condition for allowance. Reconsideration of the rejections is respectfully requested. Allowance of the claims at an early date is respectfully requested.

Applicant has considered the prior art made of record, but not relied upon by the Examiner, and believes they are less relevant than those relied on.

In order to facilitate prosecution of this application, the Examiner is respectfully requested to contact the undersigned with any comments or suggestions the Examiner may have.

Any additional charges, including Extensions of Time, please bill our Deposit Account No. 13-1130.

Respectfully submitted,

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